

R E M A R K S

Reconsideration of the application is respectfully requested. Applicant has attempted to address every objection and ground for rejection in the final Office Action dated 10 June 2005, and believes that the claims as amended are in allowable form.

CLAIM REJECTIONS – 35 U.S.C. §102 and §103

Claims 1, 2, 4, 10, 11, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as obvious over Hlavacek (U.S. Patent No. 5,572,892). Claims 1, 2, 4, 10, 11, 12 and 14 have been withdrawn.

CLAIMS REJECTIONS – 35 U.S.C. §103

Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hlavacek (U.S. Patent Number 5,572,892) in view of Osterhoff et al. (U.S. Patent No. 5,720,171).

The teachings of Hlavacek and Osterhoff do not intend for either of the two inventions to operate as the present invention. Further, even if combined as the Office Action has suggested, the resulting device will not operate as Applicant's claimed device. The Hlavacek patent teaches a one container cylinder storage unit and does not suggest or teach that the unit should be modified for multiple container storage cylinders as taught by Applicant's invention. Further, neither Hlavacek nor Osterhoff teach or suggest a device in which, whereas with Applicant's device, multiple cylinders operate so that the cylinders thermally communicate at one or more points. Moreover, the cited references, alone or in combination, do not teach a container positioning means located in a cylinder to direct the position of a stored bottle or container toward one or more locations where the cylinders thermally communicate. This is an important feature of Applicant's invention because, for example, the second cylinder may be used for cooling bottled wine that requires less cooling such as a red wine. Whereas a white wine which

requires more cooling may be stored in the first cylinder. See patent application paragraph 34. There is no suggestion in Hlavacek or Osterhoff that either of these important inventive features are intended. Moreover, neither Hlavacek or Osterhoff would operate as intended if the modifications suggested by the Office Action were made. The MPEP specifically states, at Section 2143.01:

**THE PROPOSED MODIFICATION CANNOT RENDER
THE PRIOR ART UNSATISFACTORY FOR ITS
INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, *then there is no suggestion or motivation to make the proposed modification.* *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). (emphasis added)

Further,

**THE PROPOSED MODIFICATION CANNOT CHANGE
THE PRINCIPLE OF OPERATION OF A REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching so fthe references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Osterhoff Adds Nothing to the Teaching of Hlavacek to Suggest the Present Invention

The Osterhoff '171 patent discloses a device for heating and cooling a beverage. The disclosed device provides an opening in a side wall of a storage chamber (Fig. 4) that permits a heat transfer member (Fig. 7) to protrude into the chamber so that a side of the heat transfer member contacts a beverage container stored in the chamber. Therefore, the heat transfer occurs only at an area of the heat transfer member that is in contact with the beverage container. There is no suggestion in Osterhoff that the cylinder walls and bottom should effect the heat transfer as in Applicant's invention. There is also no suggestion in either Osterhoff or Hlavacek that multiple cylinders should thermally communicate.

The Present Invention is not Suggested by the Teachings of Hlavacek and Osterhoff

As previously discussed, Applicant's invention provides a completely different way to provide for heat transfer to and from beverage containers. As shown in the application, drawings and claims 19 and 20, applicant's invention provides for a container to be placed in one or more of the storage cylinders whereby the container is in contact with the cylinder wall and the bottom of the cylinder. In applicant's device, the cylinders are constructed of thermally conductive materials and heat transfer occurs as a result of the container being in contact with and surrounded by the thermally conductive walls of the cylinder, the Osterhoff device is not constructed this way and does not teach this method of operation. Moreover, Osterhoff teaches away from this type of operation because a container stored in the Osterhoff device will not even contact the bottom of the chamber and instead is raised above the chamber bottom by spokes 57. See patent col. 3, lines 30-35. The U.S. patent to Hlavacek '892, even if combined with Osterhoff still does not teach applicant's invention as shown in the application and claims 19 and 20. Further, whereas with Applicant's device, multiple cylinders operate so that the cylinders thermally communicate at one or more points. Moreover, the cited references, alone or in combination, do not teach a container positioning means located in a cylinder to direct the position of a stored bottle or container toward one or more locations where the cylinders thermally communicate. Therefore, Hlavacek does not teach applicant's invention even when accompanied with the Osterhoff patent. Applicant respectfully submits that claims 19 and 20 are in condition for allowance.

As such, claims 19 and 20 distinguish over Hlavacek in view of Osterhoff and applicant respectfully requests allowance of claims 19 and 20.

Claims 6 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hlavacek '872 in view of Sola (U.S. Patent No. 2,838,916) or Cretzmeyer (U.S. Patent No. 4,580,405). Claims 6 and 16 have been withdrawn.

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hlavacek '872 in view of Kieler (U.S. Patent No. 4,204,875) or Bloch et al. (U.S. Patent No. 6,494,316). Claim 9 has been withdrawn.

RECONSIDERATION AND ALLOWANCE REQUESTED

Applicant hereby respectfully requests reconsideration, continued examination and allowance of the claims. Applicant further requests that should another office action be required in this matter that a non-final office action issue.

A sincere effort has been made to overcome the Action's rejections and to place the application in allowable condition. Applicant invites the Examiner or Supervising Examiner to call Applicant's attorney to discuss any aspects of the invention that the Examiner may feel are not clear or which may require further discussion.

In view of the foregoing remarks and amendments, it is believed that the claims are allowable and a Notice of Allowance is respectfully requested.

Respectfully submitted,

WELSH & KATZ, LTD.

By

Richard J. Gurak
Registration No. 41,050

October 28, 2005
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, IL 60606
Phone: (312) 655-1500
Fax: (312) 655-1501